

REMARKS

Reconsideration and re-examination is respectfully requested in view of the above amendments and below remarks made in response to the office action of January 11, 2006.

Rejections under 35 U.S.C. §103

Claims 1-4, 6-0, 22-35, 37-47 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cole et al. (U.S. Patent 6,348,817) hereinafter Cole, in view of Kamioka et al (U.S. Patent 5,990,577), hereinafter Kamioka.

Cole:

Cole describes a system in which remote nodes are supplied with electrical power using existing network communication links. The communication links are *unused* links, ‘For example, the replaced capability may be full duplex transmission. This nevertheless yields the ability to power remote nodes while retaining substantially all of the communication capability of the communication link 30. For example, the capability of half duplex transmission may be retained...’ Thus Cole effectively steals ‘unused’ links to provide power to nodes.

Kamioka

Kamioka describes a construction of a power supply that drives signal processing logic in a hub to allow the hub to maintain its function even when power failure occurs. (Kamioka, col. 1, lines 15-16). In particular, Kamioka describes, at column 4, lines 3-7:

“... The power supply circuit 10 is connected with an external ac power supply and provides a rectified and stabilized dc power to the other circuits of the hub 1. The power supply circuit 10 also includes a backup power supply circuit...”

The signal processing circuit performs primary functions of repeating the transmitted signal among nodes in the network and reshaping the signal. The backup power supply circuit is described at column 4 lines 42-46:

“... In the power supply circuit 10, a lead acid battery is typically employed as a backup secondary battery 13. A charging circuit 14 for trickle charging the secondary battery 13 is connected to the +15v output terminal of the ac/dc converter 11....”

No mention or suggestion is found in Kamioka for delivering “... power from energy stored by the electrochemical power source to at least one selected member network device...” as recited in the claims. Rather, Applicants note that the backup battery in Kamioka is used solely for the purpose of delivering power to the hub, not for passing power to downstream network devices.

The Examiner states, at pages 2-3 of the office action:

“... Cole discloses a central network device (the communication device 12...) for use in a power integrated local area network, the central device comprising... an electric power source ... and a network interface configured to communicate with a plurality of member devices (nodes 20...) and to deliver power ... to at least one selected member network device...”

Cole fails to explicitly disclose the power source is electrochemical source i.e., battery powered source.

Kamioka, on the other hand, discloses a hub for a local area network ...The power supply circuit further comprises an ac/dc converter for converting an ac current applied from an external ac power supply...

Therefore it would have been obvious to one having ordinary skill in the art at the time of invention was made to apply the teaching of Kamioka especially backup battery power supply in the system taught by Cole for providing a hub equipped with a backup power supply... and providing the hub which is able to avoid breakdown of a whole network system in case of power failure of a defect caused in a power supply wiring without using an expensive uninterruptible power supply facility...”

Applicants disagree with the Examiner’s conclusions with regard to the combination of Cole and Kamioka, and respectfully submit that the combination fails to satisfy the burden for establishing a prima facie case of obviousness with regard to the claims of the present invention.

As described in M.P.E.P. §2143, ‘To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations...”

No motivation for the modification suggested by the Examiner

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

The Examiner’s motivation for modifying the references appears to be that ‘providing the hub which is able to avoid breakdown of a whole network system in case of power failure of a defect caused in a power supply wiring without using an expensive uninterruptible power supply facility...”

Applicants note that the power supply of Cole is shown in Figure to be *external* from the communication device 12. Accordingly, should one be motivated to modify Cole as suggested by the Examiner, it would appear that the power supply would be modified, not the communication device 12. Any suggestion that one would be motivated to modifying the communication device 12 to include a backup power system can only be found by using hindsight based on the teachings of the present invention.

“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *Dembiczak*, 175 F.3d at 999; see also *Ruiz*, 234 F.3d at 665 (explaining that the temptation to engage in impermissible hindsight is especially strong with seemingly simple mechanical inventions). This is because “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” *Dembiczak*, 175 F.3d at 999. Therefore, we have consistently held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000)

Applicants respectfully submit that no motivation is shown or suggested by the references to combine Cole and Kamioka in the manner claimed; i.e., by including a backup power in the communication device 12. Accordingly, for at least the reason that there is no motivation for the modification suggested by the Examiner, the rejection under 35 U.S.C. §103 is improper and should be withdrawn.

Combination neither describes nor suggests the claimed invention

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Applicants

submit that the combination of Cole and Kamioka fail to teach or suggest several limitations of the claims.

For example, claim 1 recites “...a network interface configured to communicate with a plurality of member network devices *via a combined power/data link* and *to deliver power* from energy stored by the electrochemical power source to at least one selected member network device *via the combined power/data link*, the at least one selected member network device being capable of accepting power over the power integrated local area network...”

Thus the present invention is directed to a power integrated network; i.e., a network such as that of 802.3af where both data and power are transmitted simultaneously on a common carrier. Applicants have amended the claims to more clearly recite that the links of the present invention are ‘combined power/data’ links. Such a limitation clearly distinguishes the present invention from Cole, which explicitly states, at column, lines 22-23 ‘The communication device 12 uses lines 44 which are *unused...*’

Cole, in fact, explicitly teaches away from the use of combined power/data links at column 1, lines 32-37:

“Another method for providing power to remote nodes is to superimpose the signaling required for communication with the remote nodes onto the conductors that supply power to the remote nodes. Unfortunately, such a method usually increases the cost of the remote nodes. In addition, such a method usually increases the complexity of the communication circuitry...”

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) The Examiner cannot ignore the portions of Cole which teach against the claimed invention.

Accordingly, for at least the reason that the combination of references fails to describe or suggest "... deliver power from energy stored by the electrochemical power source to at least one selected member network via the combined power/data link" claim 1 is patentably distinct over the combination of Cole and Kamioka, and the rejection should be withdrawn.

Independent claims 16, 17, 32, 46 and 47 similarly recite the use of 'combined power/data links' for forwarding data and power to network elements, and are therefore allowable for at least the same reasons as put forth above with regard to claim 1. Dependent claims 2-15, 18-31 and 33-45 serve to add further patentable limitations to their associated parent claims, but are patentable for at least the reason that they depend upon patentable subject matter.

Conclusion

The Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone the undersigned, Applicants' Attorney at 978-264-6664 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

April 14, 2006 _____
Date

s/Lindsay McGuinness/ _____
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Docket No. 120-235